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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/726,296   | 11/30/2000  | Henry N. Holtzman    | PRT-007             | 4729             |
| 51414  | 7590        | 12/12/2005           | EXAMINER            |                  |
| GOODWIN PROCTER LLP<br>PATENT ADMINISTRATOR<br>EXCHANGE PLACE<br>BOSTON, MA 02109-2881 |             |                      | HAMILTON, LALITA M  |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3624                |                  |

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/726,296

Applicant(s)

HOLTZMAN ET AL.

Examiner

Lalita M. Hamilton

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date March 31, 2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Summary**

On September 30, 2005, an Office Action was mailed to the Applicant rejecting claims 1-23. On March 31, 2005, the Applicant responded by amending claims 1, 13-14, and 23.

### ***Information Disclosure Statement (IDS)***

The information disclosure statement (IDS) submitted on March 31, 2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the Examiner.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-8, 10-15, 17-19, and 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Withrow (6,116,505), as set forth in the previous Office Action.

With regard to amended claims 1, 13-14, and 23, Withrow discloses obtaining previously stored user information based on the identifier (col.1, line 64 to col.2, line 20 and col.5, lines 44-52).

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3, 9, 16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withrow in view of Klein (6,178,426), as set forth in the previous Office Action.

***Response to Arguments***

Applicant's arguments filed March 31, 2005 have been fully considered but they are not persuasive. The Applicant argues that Withrow does not disclose "identifying a form presented to a user in a computer application program". In response, when a user is giving authorization, a computer application program is being used. Withrow discloses that the user is required to give authorization and to request service by entering various types of information into the system (col.1, line 64 to col.2, line 20; col.6, lines 5-53; and col.7, line 20-65). This may be interpreted as "identifying a form

presented to a user in a computer application program, the form request information about the user". Therefore, the Examiner is interpreting Withrow as reading onto the invention substantially as claimed.

The Applicant argues that Klein does not disclose "generating a unique identifier based on the card information" or "obtaining previously stored user information based on the identifier". In response, nowhere in the previous Office Action did the Examiner incorporate Klein as a teaching of generating a unique identifier based on the card information" or "obtaining previously stored user information based on the identifier".

The Applicant argues that neither reference discloses or suggests using a unique identifier to obtain previously stored user information. In response, Withrow discloses the user of a unique identifier (i.e. PIN, biometric data, etc.) when completing an authorization "form". Therefore, the Examiner is interpreting Withrow as reading onto the invention substantially as claimed.

Regarding claims 13 and 14, the Applicant argues that neither Winthrow nor Klein disclose or suggest any of the elements of the claims. In response, Withrow disclose receiving a magnetic stripe card comprising a unique identifier (col.1, line 64 to col.2, line 20); obtaining previously stored information based on the unique identifier (col.1, line 64 to col.2, line 20); matching elements of user information with elements of information about the user requested form (col.1, line 64 to col.2, line 20; col.6, lines 5-53; and col.7, lines 20-65); and receiving an RFID tag comprising a unique identifier (col.1, line 64 to col.2, line 20; col.6, lines 5-53; and col.7, lines 20-65). Therefore, the Examiner is interpreting Withrow as reading onto the invention substantially as claimed.

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The Applicant argues that neither Withrow nor Klein disclose or suggest a dispatch module for associating the unique identifier with a user or obtaining previously stored information based on the unique identifier. In response, Withrow discloses a dispatch module for associating the unique identifier with a user col.1, line 64 to col.2, line 20; col.6, lines 5-53; and col.7, lines 20-6) and obtaining previously stored information based on the unique identifier (col.2, lines 1-20). Therefore, the Examiner is interpreting Withrow as reading onto the invention substantially as claimed.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M. Hamilton whose telephone number is (571) 272-6743. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
LMH

VINCENT MILLIN  
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